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PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## In Re Application of

Applicant : C. L. Bates, et al.  
Serial No. : 09/934,913  
Filed : 22 Aug 2001  
  
Examiner : Dennis William Ruhl  
Art Unit : 3629  
  
Entitled : System and Method for Selecting, Recording, and  
Transmitting Video Images (as amended)  
  
Docket No. : END920010062US1  
  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

DECLARATION OF PRIOR INVENTION IN THE UNITED STATES  
OR IN A NAFTA OR WTO MEMBER COUNTRY  
TO OVERCOME CITED PATENT OR PUBLICATION (37 C.F.R. § 1.131)

## PURPOSE OF DECLARATION

1. This declaration is to establish completion of the invention in this application in the United States, at a date prior to Jul. 30, 2001,

## CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10

I hereby certify that, on the date shown below, this correspondence is being:

## MAILING

- ☐ deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10

- ☐ with sufficient postage as ☐ as "Express Mail Post Office to Addressee"  
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## TRANSMISSION

- ☒ facsimile transmitted to the Patent and Trademark Office, (703) 872-9306.

Signature

Lisa M. Plank

Date: April 26, 2005

(Type or print name of person certifying)

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that is the effective date of the prior art:

- ☒ publication
- ☐ patent

that was cited by the

- ☒ examiner.
- ☐ applicant.

2. The person making this declaration is (are):

- ☒ the inventor(s).
- ☐ only some of the joint inventors (and a suitable excuse is attached for failure of the omitted joint inventor(s) to sign).
- ☐ the party in interest (and a suitable explanation as why it is not possible to produce the declaration of the inventor(s) is attached).

#### FACTS AND DOCUMENTARY EVIDENCE

3. To establish the date of completion of the invention of this application, the following attached documents and/or models are submitted as evidence:

- ☒ sketches
- ☐ blueprints
- ☐ photographs
- ☐ reproduction(s) of notebook entries
- ☒ invention disclosure documents
- ☐ model
- ☐ product specifications
- ☐ product announcements
- ☐ supporting statement(s) by witness(es) (where verbal disclosures are the evidence relied upon)

#### DILIGENCE

4. Following is a statement establishing the diligence of the applicants, from the time of their conception, to a time just prior to the date of the reference, up to the:

- ☐ actual reduction to practice.
- ☒ filing of this application.
- ☐ no such statement is required inasmuch as the actual reduction to practice occurred prior to the date of the reference.

On information and belief, the following events occurred on or about the dates indicated:

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- 20 Oct 2000 An information disclosure document created by Gilford Martino was prepared, and last modified on or about 8 Dec 2000 and submitted to applicants' employer (IBM) by the latter date for processing, which document describes the invention. Copy attached.
- 15 Feb 2001 A evaluation of the information disclosure document was prepared by Edward Stavara, of IBM, recommending that a search be conducted. Copy attached.
- 09 May 2001 A patentability search report was previously requested of, and completed and submitted to IBM by Richard A. Booth, Jr. Copy attached.
- 15 May 2001 A decision was reached by William Schiesser, IBM patent agent, to file a patent application, and outside counsel, Shelley M Beckstrand, was engaged to do so. Copy of engagement letter attached.
- Outside counsel time records show that work on the patent application was logged during 2001 for May 16 and 18; June 14; and July 11, 12, 16, 17, and 19. Copy of time log attached.
- 18 May 2001 Exchange of E-mail notes between Gilford Martino and Shelley Beckstrand regarding materials and arranging a meeting for preparing the application. Copy attached.
- 18 May 2001 E-mail note to Shelley Beckstrand from William Schiesser resetting due date for completing the application to 23 Jul 2001. Copy attached.
- 21 May 2001 Note of telephone conversation by John Santosuosso with Shelley Beckstrand regarding materials for the application. Copy attached.
- 30 May 2001 Fax transmission of flow charts for use in the application specification from John Santosuosso to Shelley Beckstrand. Copy attached.
- 14 Jun 2001 E-mail note to John Santosuosso from Shelley Beckstrand re status of preparation of the application. Copy attached.
- 16 Jul 2001 Draft application sent to John Santosuosso by Shelley Beckstrand for markup. Copy of E-mail note attached.
- 18 Jul 2001 Markup of draft application faxed by John Santosuosso to Shelley Beckstrand. Copy attached.
- 19 Jul 2001 Gilford Martino and John Santosuosso approval of draft application by E-mail to Shelley Beckstrand. Copy attached.
- 19 Jul 2001 Application completed and submitted by Shelley Beckstrand to IBM for filing in the USPTO. Copy of invoice attached.
- 22 Aug 2001 The above identified patent application, S/N 934,913 (END920010062US1), was filed in the USPTO.

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## TIME OF PRESENTATION OF THE DECLARATION

5. This declaration is submitted:

- ☒ prior to final rejection.
- ☐ with the first response after final rejection, and is for the purpose of overcoming a new ground of rejection or requirement made in the final rejection.
- ☐ after final rejection. A showing under 37 C.F.R. § 1.116(b) is submitted herewith.

## DECLARATION

6. As a person signing below:

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

## SIGNATURE(S)

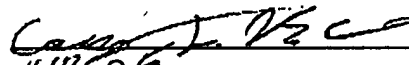
7. (Complete A or B)

## A. Inventor(s)

Full name of sole  
or first inventor:

CARY L. BATES

Inventor's signature



Date:

4/26/05

Country of Citizenship:

U.S.A.

Residence:

450 73RD ST. NW, ROCHESTER, MN 55901

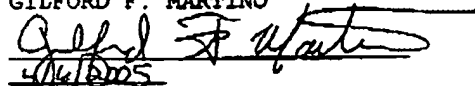
P.O. Address

Same as Residence

Full name:

GILFORD F. MARTINO

Inventor's signature



Date:

4/26/05

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Full name: JOHN M. SANTOSUOSSO  
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Full name: VINCENT T. TIMON, III  
Inventor's signature *Vincent T. Timon III*  
Date: 4/6/2005  
Country of Citizenship: U.S.A.  
Residence: 31 BROOK AVE., BINGHAMTON, NY 13903  
P.O. Address: Same as Residence

**B. Assignee**

Name and title of person  
authorized to sign on behalf  
of assignee:

Signature:

Date:

P.O. Address:

Name of Assignee:

Address of Assignee:

International Business Machines  
Corporation  
Armonk, New York

Assignment recorded in PTO  
on date: \_\_\_\_\_  
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☐ A certificate under 37 C.F.R. § 3.73(b) is attached.

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